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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,476	05/24/2001	Yasuhiro Shinkai	Q64648	1262

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Washington, DC 20037

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,476

Applicant(s)

SHINKAI, YASUHIRO

Examiner

Tan Dean Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/24/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received on 08/08/01
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5, 6-9, 10, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims, it's not clear the relationship between "an image printer" and "a voucher printer". Is it the same printer having different names or different printer?

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 10,1-5, 11, 6-9 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WATANABE et al (US 6,578,072).

As for claim 10, WATANABE et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of: (a) transferring to an image printer ordered image data and order information, and instructing a printer to print a voucher including thumbnail images and details of the order on the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer (see col. 1, lines 10-25 (or 1:10-25), 2:55-67, 3:1-15, 5:37-60, 6:8-55, Fig. 2). Alternatively, the various printing options such as type, size, resolutions, etc. is taught by WATANABE et al on 6:40-58 and would have been obvious to an artisan as mere routine experimentations to select the desired printed image.

As for claim 1, WATANABE et al discloses a print order acceptance system for accepting an order for printing images on the basis of digital image data, wherein the system comprises: (a) an order acceptance machine which accepts digital image data and order information and transfer the image data and the order information to an image printer, and a printer which prints an image including thumbnail images and details of the order on the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer (see col. 1, lines 10-25 (or 1:10-25), 2:55-67, 3:1-15, 5:37-60, 6:8-55, Fig. 2). Alternatively, the various printing options such as

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type, size, resolutions, etc. is taught by WATANABE et al on (6:40-58) and would have been obvious to an artisan as mere routine experimentations to select the desired printed image.

As for claims 2-3, they are shown on col. 6, lines 25-56, wherein printing out of images ordered are provided. As for claims 4-5, they are taught on col. 6, lines 50-65. As for claims 6, 11, WATANABE et al discloses a digital photographic service system and method which enables browsing, downloading (transmitting images), and ordering printing of the registered imaged, is provided to the user (6:27-40). As for the ordering of the image in the form of electronic mail, WATANABE et al discloses that the user can access and communicate with the system using Internet or WWW browser (Fig. 2, 6:27-38). The use of Email or other well known electronic communications in view of the advantage of the Internet or web-related business would have been obvious as using well known equivalent means for electronic communication. As for claims 7-9, they are rejected for the same reasons set forth in claims 3-5 since they are basically the same claims.

6. Claims 6-9, 11 are rejected (2<sup>nd</sup>) under 35 U.S.C. 102(b) as being anticipated by ARTICLE 9/1996.

As for claims 11, 6, ARTICLE 9/1996 discloses method and photographic service system comprising the steps and means for of transferring to an image printer ordered image data and order information, and means for transmitting thumbnail images corresponding to image data which have been transferred to the image printer and the order information (see pages 1-2).

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As for claims 7-9, they are also taught on page 2 as indicated by the brackets.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Foreign: JP 2001/339557 discloses an print order accepting system.

JP 2003/118210 discloses a digital image receiver for network printing system.

2) NPL:

a) The article "Web-based Services offer many options for Digital Camera owners" discloses various personal and convenient options for handling photos.

b) The article "Fujifilm ...Fujifilm.Net" is cited to teach the storing digitized photo, sending the photo to other people, and ordering the photo.

c) The article "Digital Photography .. Confused" is cited to teach various steps of storing digitized photo, sending the photo to other people, and ordering the photo.

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8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn

  
DEAN T. NGUYEN  
PRIMARY EXAMINER